

**REMARKS**

The present amendment is submitted in response to the Office Action dated August 25, 2003, which set a three-month period for response, making this amendment due by November 25, 2003.

Claims 23-44 are pending in this application.

In the Office Action, claims 23, 33, and 35 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 23, 24, 26, 27, 28, 29, 30, 31, 33, 34, 35, 37, 38, 39, 43, and 44 stand rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,659,960 to Toya et al. Claims 25 and 36 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Toya et al in view of U.S. Patent No. 5,852,340 to Ito et al. Claim 32 was rejected under 35 U.S.C. 103(a) as being unpatentable over Toya et al. Claims 40 and 41 were rejected under 35 U.S.C. 103(a) as being unpatentable over Toya et al in view of U.S. Patent No. 4,183,746 to Pearce et al. Claim 42 was rejected under 35 U.S.C. 103(a) as being unpatentable over Toya et al in view of Pearce et al, as applied to claims 40 and 41, and further in view of U.S. Patent No. 5,055,442 to Osaka et al.

In this amendment, the specification has been amended to add or change the sectional headings and to delete reference to the claims.

The claims were amended to address the rejections under Section 112, and to adopt the correct claim numbering (claims 23-44, rather than 1-22) in the claim dependencies.

Regarding the substantiv rejections of the claims, claims 23 and 34 have been amended to define that the cermet is disposed between the central electrode and the terminal stud. Support for this limitation can be found in the specification on page 4, lines 14-18.

The Applicant respectfully submits that amended claims 23 and 34 define a patentably distinct set of features neither shown nor suggested by the cited references and reference combinations.

The primary reference to Toya describes a center electrode 4, 42 from a cermet. The center electrode 4, 42 is arranged in the combustion chamber and is arranged adjacent to the ground electrode. Upon application of an ignition voltage, the spark gap is formed between the center electrode and the ground electrode. The spark gap, then, terminates on the cermet. Within the isolate, an element 45 designated as the center electrode is provided. The advantage of such an arrangement, in addition to simpler manufacture, is that the cermet-center electrode has a high resistance against spark erosion (degradation of the center electrode with the occurrence of an ignition spark).

According to the present invention, however, a metallic (for example, platinum) center electrode is provided, on whose end remote from the combustion chamber a cermet is connected. The cermet is separated by the platinum center electrode from the combustion chamber. The spark gap terminates on the metallic center electrode, not, however, on the cermet. The advantage of the present invention of a cermet connecting to the metallic center electrode is that the center bore of the isolate is sealed by the cermet.

Thus, the present invention, as defined in claims 23-44, differs fundamentally both in structure and function from the device disclosed in the primary reference to Toya. Thus, Toya does not anticipate the subject matter of independent claims 23 and 34, when anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984).

Likewise, the combination of the Toya patent with the various secondary references does not render obvious the subject matter of the rejected claims, because none of the cited references discloses or suggests the arrangement of a cermet between a center electrode and a terminal stud. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Fritch*, 23 USPQ 2d 1780, 1783-84 (Fed. Cir 1992). In the present case, none of the secondary references suggests the desirability of the modification proposed by the Examiner.

In addition, obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 221 USPQ 929, 932, 933 (Fed Cir. 1984). The prior art of record fails to provide any such suggestion or incentive.

For the reasons set forth above, the Applicants respectfully submit that claims 23-44 are patentable over the cited references. The Applicants further request withdrawal of the rejections under 35 U.S.C. 102 and 103 and reconsideration of the claims as herein presented.

In light of the foregoing arguments in support of patentability, the Applicant respectfully submits that this application stands in condition for allowance. Action to this end is courteously solicited.

Should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,



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